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PATENT APPLICATION

THE UNITED STATES PATENT AND TRADEMARK OFFICE

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5/15/03

In re application of

Docket No: Q65015

Judith REINHARD, et al.

Appln. No.: 09/868,785

Group Art Unit: 1616

Confirmation No.: 6194

Examiner: John D. Pak

Filed: June 21, 2001

For: TERMITE ATTRACTANT AND/OR FEEDING STIMULANT

**RESPONSE TO RESTRICTION REQUIREMENT**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In response to the restriction requirement, dated April 10, 2003, Applicant elects Group II, claims 1-5, 8-18, 22-34, 35-51, 54-64 for examination. This election is made with traverse.

Traversal is on the ground that the Examiner has made technical mistakes in characterizing the compounds of Group I and Group III. As a result, the Examiner was led to the mistaken conclusion that the compounds of the groups defined by the Examiner do not belong to a recognized class of chemical compounds.

More specifically, in supporting the issuance of the Restriction Requirement, the Examiner used the policy that when a Markush grouping is for alternatives of chemical compounds, they should be regarded as being of a similar nature where:

- (A) All alternatives have a common property or activity, and
- (B)(1) A common structure is present, *i.e.* a significant structural element is shared by all of the alternatives; or
- (C)(2) In cases where the common structure cannot be the unifying criteria, all alternatives belong to a recognized class of chemical compounds in the art to which the invention pertains.

The Examiner stated that in the present case, neither conditions (B)(1) nor (C)(2) is met.

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Applicant's submit, respectfully, that the Examiner is incorrect.

More specifically, the Examiner characterizes Group I compounds as compounds that have at least two OR groups attached to an aryl moiety and at least one of R is a carbohydrate moiety, such as  $\beta$ -arbutin. The Examiner characterizes Group III compounds as having a catechol type structure, *i.e.*, contains a benzopyran moiety.

With respect to Group I, the Examiner is correct that  $\beta$ -arbutin contains a carbohydrate moiety, but not that this is the most significant structural moiety in the compound. In fact, hydrolysis of  $\beta$ -arbutin, *i.e.*, removal of the carbohydrate moiety, results in the active moiety, p-hydroquinone.

As to Group III, the common name catechol is apparently applied to two different compounds. If one refers to the Merck Index, 12<sup>th</sup> Edition, the intended structure is given the name "pyrocatechol" with the synonym "catechol" being listed - it is entry 8183. The systematic name for the compound is 1,2-dihydroxybenzene, and it is within formula 1 recited in claim 9. The compound referred to by the Examiner is entry number 1950 and is given the name "catechin" but also the synonym "catechol."

Therefore, the Examiner is incorrect on two points: (1) in placing reliance on the carbohydrate moiety as the key structural element in  $\beta$ -arbutin and (2) in identifying the nature of catechol. This leads to the mistaken conclusion in relation to (C)(2) that all alternatives do not belong to a recognized class of chemical compounds. The class of chemical compounds claimed are those of general formula 1 set forth in claim 9 (including catechol), their precursors and additional compounds and oligomers containing them.

Accordingly, the compounds of the present invention meet the criteria of having a common property or activity and belonging to a recognized class of chemical compounds. As a result, the restriction within the Markush grouping is improper and should be removed.


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Favorable consideration is respectfully requested.

Applicants reserve the right to file a Divisional Application directed to non-elected claims.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

  
Susan J. Mack  
Registration No. 30,951

SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

WASHINGTON OFFICE



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Date: May 12, 2003